

REMARKS:

Status Of Claims

Claims 1-7 and 23-30 were previously and are currently pending in the application with claims 1 and 24 being independent.

Office Action

In the Office Action, the Examiner rejected claims 1-7, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the limitation "wherein the navigation device ... is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly" contains new matter. However, the specification, as originally filed, is replete with references to the preferred navigation device being "a conventional, portable navigation device". Page 4, Lines 15-17; Page 6, Lines 4-9; Page 7, Lines 22-30; Page 11, Lines 3-8; Page 24, Line 21, thru Page 25, Line 3. Furthermore, on page 2, lines 9-10, the originally filed specification discloses "[o]ne such navigational device is sold by Garmin International, Inc., under the trade name ETREX". Such conventional, portable navigation devices are known to be "functional as a navigation device ... when being used independently of the mounting assembly".

Additionally, on page 2, lines 29-31, the originally filed specification identifies "a need for a navigational device that can be used in a vehicle not originally equipped with a navigational device without need for a dashboard mount". Finally, on page 6, lines 16-18,

the originally filed specification discloses that "[t]he navigational device may be quickly and easily placed in the docking station **for use in the vehicle** and removed therefrom **for use outside the vehicle**", emphasis added. Thus, the limitation "wherein the navigation device ... is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly", is fully supported by the specification, as filed. As a result, the Examiner's rejection of claims 1-7 under 35 U.S.C. § 112, first paragraph, cannot be sustained.

The Examiner also rejected claim 23, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the limitation "wherein the support pillar runs along and directly above the vehicle's windshield" contains new matter. Applicant calls the Examiner's attention to Figures 19-22 and their accompanying description on pages 24-28. Furthermore, on page 6, lines 7-9, the originally filed specification discloses that "[t]he mounting assembly is attached to or integrally formed with a trim piece that replaces trim or molding covering a support pillar of the vehicle above the vehicle's windshield". Thus, the limitation "wherein the support pillar runs along and directly above the vehicle's windshield", is fully supported by the specification, as filed. As a result, the Examiner's rejection of claim 23 under 35 U.S.C. § 112, first paragraph, cannot be sustained.

The Examiner also rejected claims 27-28, under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Examiner asserts that the limitation "a retractable face plate mounted within the docking station and

operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station" contains new matter. Applicant calls the Examiner's attention to Figure 22 and the accompanying description on page 25-28. More specifically, on page 26, lines 19-26, the originally filed specification discloses:

In operation, when the navigational device 10k is loaded or mounted into the docking station 200k, the retractable face plate 202k will retract generally flush with a rear face 214k of the docking station 200k. When the navigational device 10k is removed from the docking station 200k, the retractable face plate 202k extends forward, such that the plate 202k is generally flush with a front face 216k of the docking station 200k. The retractable face plate's purpose is to cover the rectangularly-shaped cut-out 208k of the docking station 200k and thus, is for general aesthetic purposes only.

Thus, the limitation "a retractable face plate mounted within the docking station and operable to retract when the navigation device is received within the docking station and extend when the navigation device is removed from the docking station, thereby covering the void left in the docking station", is fully supported by the specification, as filed. As a result, the Examiner's rejection of claims 27-28 under 35 U.S.C. § 112, first paragraph, cannot be sustained.

The Examiner also rejected claims 27-28, under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asserts that claim 24 is drawn to the invention disclosed in Figure 14 and that claim 27, which depends from claim 24, is not related to Figure 14. However, claim 24 is not limited to Figure 14.

Furthermore, the retractable face plate is fully supported by the specification, as discussed above, and shown in the drawings. Finally, claim 24's reference to "an existing support pillar" is also fully supported by the specification, as described above with respect to claim 23. Thus, claim 27 is fully supported by the specification, as filed. As a result, the Examiner's rejection of claims 27-28 under 35 U.S.C. § 112, first paragraph, cannot be sustained.

The Examiner also rejected claims 1-6 and 23-29 under 35 U.S.C § 103(a) as being unpatentable over Kempkers et al., U.S. Patent No. 5,415,554, in view of Schoenfish, U.S. Patent No. 6,370,037, and Funk et al., U.S. Patent No. 6,681,176. The Examiner also rejected claims 7 and 30 under 35 U.S.C § 103(a) as being unpatentable over Kempkers in view of Schoenfish and Funk, in further view of Ockerse, U.S. Patent No. 6,928,366. Applicant respectfully submits that the currently pending claims distinguish the present invention from Kempkers, Schoenfish, Funk, Ockerse, and the other prior art references of record, taken alone or in combination with each other.

Legal Discussion of Obviousness

Obviousness can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has the benefit of the applicant's disclosure as a blueprint and guide. In contrast, one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the applicant is in the

exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection.

For these reasons, the law places upon the Examiner the initial burden of establishing a *prima facie* case of obviousness. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the Applicant to provide evidence to refute the rejection.

In meeting this initial burden, the Examiner "cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Fine*, 837 F.2d 1071, 1075, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). Thus, the Examiner is required to perform the "critical step" of casting his or her mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See, e.g., W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 U.S.P.Q. 303 (Fed. Cir. 1983).

Rejections on obviousness grounds also cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. *In re Kahn*, 441 F.3d 977, 988, 78 U.S.P.Q.2d 1329 (Fed. Cir. 2006). The factual inquiry performed by the Examiner in issuing an obviousness rejection must be thorough and searching. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 U.S.P.Q.2d 1001 (Fed. Cir. 2001). The prohibition against conclusory examination is as much rooted in the Administrative

Procedure Act, which ensures due process and non-arbitrary decision-making, as it is in § 103. *In re Kahn*, 441 F.3d at 988.

Three criteria must be satisfied by the Examiner in order to establish a prima facie case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) the combination of references must teach or suggest all the claim limitations. See MPEP § 706.02(j), citing *In re Vaeck*, 947 F.2d 488, 493, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). This "motivation-suggestion-teaching" requirement protects against the entry of hindsight into the obviousness analysis, a problem which § 103 was meant to confront. *In re Kahn*, 441 F.3d at 988.

Consequently, an Examiner's mere identification in the prior art of each individual element claimed is insufficient to defeat the patentability of a claimed invention without a proper suggestion to combine or modify the elements. *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125 (Fed. Cir. 1984).

In presenting the suggestion or motivation to combine prior art references, the Examiner may not resort to broad and conclusory statements; as such statements are not "evidence" of anything. *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q.2d 1313 (Fed. Cir.

2000). The suggestion to make the claimed combination must be found in the prior art, not in the applicant's disclosure. *In re Vaeck*, 947 F.2d at 490. If the Examiner's proposed combination renders the prior art invention unsatisfactory for its intended purpose, or changes its principal of operation, there can be no suggestion or motivation to form the combination—and thus no *prima facie* case of obviousness. See MPEP § 2143.01; *In re Gordon*, 733 F.2d at 902.

Claim 1 recites “a portable navigational device” and “a mounting assembly for mounting on a support pillar of the vehicle and sized and configured to removably receive the navigational device, wherein the navigation device remains visible when received within the mounting assembly and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly”.

In contrast, no proper combination of Kempkers, Schoenfish, and/or Funk discloses, suggests, or makes obvious “a portable navigational device” and “a mounting assembly for mounting on a support pillar of the vehicle and sized and configured to removably receive the navigational device, wherein the navigation device remains visible when received within the mounting assembly and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly”, as claimed in claim 1. In fact, Kempkers explicitly teaches away from such a combination. For example, Kempkers teaches a compass assembly that is inaccessible without first completely disassembling its mounting assembly and cannot function independently of its mounting assembly. Therefore, Kempkers explicitly teaches away from the compass being

removably received therein. At the very least, modifying Kempkers compass to be removable changes its principal of operation, there can be no suggestion or motivation to form the combination—and thus there can be no *prima facie* case of obviousness. See MPEP § 2143.01.

Furthermore, as shown in figure 5 and taught in column 3, line 50, thru column 4, line 6, "the trim panel connecting link 20 [upon which Kempkers' compass 50 is mounted] provides an electrical connection between circuits 60 and 70". Thus, in addition to changing its principal of operation, making Kempkers' compass 50 removable would render "the [Kempkers] invention unsatisfactory for its intended purpose", namely providing "an electrical connection between circuits 60 and 70".

Thus, the Examiner's proposed modification of Kempkers to meet the limitations of the currently pending claims would not only change Kempkers' principal of operation, but would in fact render Kempkers unsatisfactory for its intended purpose. As a result, no proper combination of Kempkers, Schoenfish, and/or Funk discloses, suggests, or makes obvious "a portable navigational device" and "a mounting assembly for mounting on a support pillar of the vehicle and sized and configured to removably receive the navigational device, wherein the navigation device remains visible when received within the mounting assembly and is functional as a navigation device both when received within the mounting assembly and when being used independently of the mounting assembly", as claimed in claim 1.

Claim 23 recites "wherein the support pillar runs along and directly above the vehicle's windshield". The Examiner mistakenly asserts, on page 7 of the Office Action, that "Kempfers discloses (Fig. 1) wherein the support pillar (18) is a pillar". However, as clearly shown in Kempfers' Figure 1, and stated in column 2, lines 30-64, his support pillar 18 is the vehicle's "A-pillar", which runs **alongside** the vehicle's windshield, but not **above**, as currently claimed. Rather than citing prior art that teaches each and every claim limitation, as required of a prima facie case of obviousness, the Examiner merely asserts that this difference "is an obvious design choice". Page 7 of the Office Action.

However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." MPEP § 2144.04 citing *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

In the present case, the Examiner has not provided any "motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." In contrast, Applicant asserts that there is no suggestion or motivation, found in the prior art, to modify Kempfers, Schoenfish, and/or Funk to meet the limitations of the currently pending claims. Thus, no proper combination of Kempfers, Schoenfish, and/or Funk discloses, suggests, or makes obvious "wherein the support pillar runs along and directly above the vehicle's windshield", as claimed in claim 23 which depends from claim 1.

Claim 24 recites "a stand-alone hand-held portable navigational device" and "a mounting assembly for mounting on an existing support pillar of the vehicle and sized and configured to mate with the support pillar and removably receive the navigational device, such that the navigation device remains visible and fully functional when received within the mounting assembly". In contrast, as discussed above, Kempkers' compass assembly cannot function independently of its mounting assembly and to modify it to do so would not only change Kempkers' principal of operation, but would in fact render Kempkers unsatisfactory for its intended purpose. As a result, no proper combination of Kempkers, Schoenfish, and/or Funk discloses, suggests, or makes obvious "a stand-alone hand-held portable navigational device" and "a mounting assembly for mounting on an existing support pillar of the vehicle and sized and configured to mate with the support pillar and removably receive the navigational device, such that the navigation device remains visible and fully functional when received within the mounting assembly", as claimed in claim 24.

The remaining claims all depend directly or indirectly on claims 1 or 24, and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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